

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
Ex parte Hlavka et al.
Appeal No. _____

Serial No.: 10/622,207
Filed: July 18, 2003
Art Unit: 3774
Examiner: William H. Matthews
Inventor: Edwin J. Hlavka et al.
Title: METHOD AND APPARATUS FOR PERFORMING CATHETER-
BASED ANNULoplasty
Attorney Docket: MICO-06C
Confirmation No.: 4023

Cincinnati, Ohio 45202

July 10, 2009

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. §41.41

This Reply Brief responds to the Examiner's Answer mailed May 12, 2009.

Appellants respectfully request that the rejections of pending claims 60-67 be reversed in view of the remarks herein, together with Appellants' Brief on Appeal filed December 9, 2008.

REMARKS

The Examiner maintains the rejections set forth in the final Office Action dated September 2, 2008, rejecting pending claims 60-67 under 35 U.S.C. §112, first paragraph. Appellants respectfully traverse the additional arguments presented in the Examiner's Answer for the reasons set forth below.

Rejections of Claims 60-67 Under 35 U.S.C. §112, First Paragraph

The Examiner alleges that the Specification fails to support "an elongate tensioning element coupled with the non-plicating fasteners," as recited in claim 60, and argues that the term "coupled" should be interpreted to mean "intimate contact and attachment." Appellants respectfully traverse the Examiner's arguments for the reasons set forth in the Brief on Appeal filed December 8, 2008, and for the additional reasons given below.

The Federal Circuit has held that "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments." Phillips v. AWH Corp., 415 F.3d 1303, 1323 (Fed. Cir. 2005). The Court has further stated that there are "two situations where a sufficient reason exists to require the entry of a definition of a claim term other than its ordinary and accustomed meaning. The first arises if the patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition of a claim term. . . . The second is where the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d 985, 990

(Fed. Cir. 1999)(rehearing denied). Neither of these two specific situations arise in the present application. Nowhere in the Specification have Appellants set forth an explicit definition of the term "coupled," nor does that term so deprive the claim of clarity that the scope of the claim cannot be ascertained from the language used. Rather, as set forth in Appellants' Brief on Appeal, the term "coupled" is a common term in the mechanical arts that is generally recognized as referring to both direct and indirect connections, and persons of ordinary skill in the art would certainly understand that Appellants had possession of the invention so claimed upon reading the Specification.

To support his allegations that the term "coupled" should be limited to meaning "intimate contact and attachment," the Examiner refers to isolated portions of Appellants' application which describe particular embodiments, yet the Examiner admits that the term "coupled" is not used in the Specification to describe the interconnection between the elongate tensioning element and the non-plicating fasteners recited in the claims. Moreover, the Specification makes clear that the described embodiments are non-limiting examples. For example, page, 15, lines 21-23 state:

With reference to FIGS. 11a and 11b, one method of providing tension to an implant will be described in accordance with an embodiment of the present invention.

At page 16, lines 20-21, the Specification states:

It should be appreciated that the configuration of tensioning element 1140 [can] be different than shown herein.

These passages, as well as the remainder of the Specification, do not evidence any intent of Appellants to limit the meaning of the term "coupled" to mean "intimate contact and attachment" as alleged by the Examiner.

Appellants also take exception to the Examiner's assertion that coupling, in the indirect sense, is analogous to gumballs in a gumball dispenser being indirectly coupled to a knob of the gumball dispenser. The Examiner's "gumball" analogy is irrelevant to the issue presented on appeal, namely, whether Appellants' specification supports the term "coupled" as recited in claim 60. Because the originally-filed Application described the claimed invention in sufficient detail that a person having ordinary skill in the art could reasonably conclude that Appellants had possession of the claimed invention, and because a person skilled in the art could make and use the claimed invention without undue experimentation, as discussed in the Appeal Brief filed December 8, 2008, Appellants assert that the rejections of claims 60-67 under 35 U.S.C. §112 are improper.

For at least the reasons discussed above, and in further consideration of the Brief on Appeal filed December 8, 2008, Appellants respectfully urge the Board to reverse the rejections of claims 60-67 under 35 U.S.C. §112, first paragraph.

Conclusion

If there are any questions regarding the foregoing, please contact the undersigned at (513) 241-2324. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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